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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,723	03/24/2006	Richard George Leonard Morgan	HO-P03185US0	6853
26271 7590 09/08/2008 FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095				
EXAMINER				
LUKTON, DAVID				
ART UNIT		PAPER NUMBER		
1654				
MAIL DATE		DELIVERY MODE		
09/08/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/538,723

**Applicant(s)**

MORGAN ET AL

**Examiner**

DAVID LUKTON

**Art Unit**

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 9-19 and 26 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 9, 16, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Pursuant to the directives of the response filed 6/13/08, claims 1, 9, 14-16, 18 have been amended. Claims 1, 9-19, 26 remain pending.

Applicants' arguments filed 6/13/08 have been considered and found persuasive in part. The previously imposed prior art rejections are withdrawn.

Claims 1, 9, 16-19 are examined in this Office action; claims 10-15 & 26 are withdrawn.

Claims 1, 9, 16, 18, 19 are rejected; claim 17 is objected to because of its dependence on a rejected claim.

▲

The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 9, 16, 18, 19 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 makes reference to diseases in which "increased cell division occurs". The questions that arise are: (a) what diseases are encompassed by claim 1, and (b) for which diseases, is treatment (of the same) enabled?

As it happens, diseases in which “increased cell division occurs” would include bacterial infections, parasite infections, and fungal infections. Thus, claim 1 implicitly implies that the following diseases can be successfully treated:

Anthrax, Bovine Spongiform, Encephalopathy (BSE), Chicken Pox, Cholera, Conjunctivitis, Creutzfeldt-Jakob Disease, Polio, Nosocomial Infections, Otitis Media, Pelvic Inflammatory disease, Plague, Pneumonia, Dengue Fever, Elephantiasis, Encephalitis, Fifth's Disease, Rabies, Rheumatic Fever, Roseola, Rubella, Sexually Transmitted diseases, Helicobacter Pylori, Smallpox, Strep Throat, septicemia, sickle cell anemia, ulcers, Tetanus, Toxic Shock Syndrome, Lassa Fever, Leprosy, Lyme Disease, Typhoid Fever, Measles, Meningitis, Trachoma, Toxoplasmosis, Tuberculosis, Whooping Cough, Yellow Fever and candida.

Furthermore, numerous inflammatory conditions would be encompassed. One characteristic of inflammatory conditions is an “increased” level of T-cell proliferation. Numerous agents have been proposed (in the prior art) to be effective in the treatment of various inflammatory disorders by virtue of their tendency to inhibit this proliferation. Then there is the matter of acromegaly/gigantism, due to excess production of somatotropin. Here too, “increased cell division” is occurring.

Applicants have shown that the “HXP peptide” (paragraph 0226, page 35) can inhibit proliferation of leukemia cells. Also shown (e.g., figure 11) is some propensity of a peptide of the invention to inhibit growth of cancerous cells present in the skin, colon, pancreas, kidney, breast, lung, bladder, prostate, cervix, ovary and stomach. But even if one were to accept the proposition that the claims are enabled for treating any form of cancer, the claims are not limited to such.

As stated in *Ex parte Forman* (230 USPQ 546, 1986) and *In re Wands* (8 USPQ2d 1400, Fed. Cir., 1988) the factors to consider in evaluating the need (or absence of need) for "undue experimentation" are the following: quantity of experimentation necessary, amount of direction or guidance presented, presence or absence of working examples, nature of the invention, state of the prior art, relative skill of those in that art, predictability or unpredictability of the art, and breadth of the claims.

Thus, "undue experimentation" would be required to treat infectious diseases, inflammatory diseases, or diseases due to excess production of somatotropin

▲

Claims 18-19 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In claim 19, the term "PBX" may be used if accompanied by an explanation of what this term means (presumably, *pre-B-cell transformation related gene*).
- In claims 18-19, the phrase "said cells" lacks antecedent basis. In the case of claim 18, perhaps the following would constitute one solution:

*The method according to claim 1 wherein the increased cell division is occurring in cells which express one or more Hox genes.*

▲

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

/David Lukton/

Primary Examiner, Art Unit 1654